REMARKS

Reconsideration and allowance of this application in light of the foregoing amendments and accompanying remarks is respectfully requested.

THE REJECTION OF CLAIMS 10-16 IS OVERCOME

Claims 10-13, 15, and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by the U.S. Patent No. 4,934,556 (to Kleissendorf) or U.S. Patent No. 5,031,784 (to Wright). Dependent claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over either Kleissendorf or Wright.

Of the claims 10-16 pending in the application, only claim 10 is an independent claim, and claims 11-16 are each dependent upon claim 10.

Independent claim 10 has been rejected as being anticipated by either Kleissendorf or Wright. The Examiner has stated on page 2 of the Official Action that it is "inherent" that the elastomeric element in disclosed Kleissendorf and disclosed in Wright has "an outer surface that is in tension when the lid is in the closed position and has an inner surface being in ~~compress~~ [compression] when the lid is ~~in compression~~ [closed]." Applicants believe that the Examiner's language contained inadvertent errors shown by the words that have been lined through, and that the Examiner really intended to instead use the words which are shown in brackets. Applicants believe that the Examiner intended to quote or paraphrase the language of the instant application claim 10 which sets forth, inter alia, an elastomeric element that has (1) an outer surface that is "in tension" when the two members (e.g., lid and body) "are in said closed position," and (2) an inner surface that is "in compression when said two members are in said closed

position."

Applicants respectfully submit that the Examiner has incorrectly assumed that the cited references disclose inherent features.

In particular, Kleissendorf appears to disclose a hinge piece 6 which functions as a tether that is formed in a way that would not provide the features set forth in the instant application independent claim 10 with respect to tension and compression forces in the elastomeric element. In fact, Kleissendorf teaches away from the present invention as set forth in the instant application independent claim 10. Kleissendorf states, at column 2, lines 12-14, that the lid 3 must be opened by "pulling the holding loop 7." In contrast, in the instant application independent 10 (as set forth in the last clause), the members (e.g., lid and body) are instead opened by the "elastomeric element exerting a force to urge said two members from said closed position toward said open position."

Indeed, the instant application claimed hinge structure is not susceptible of the specific design taught by Kleissendorf at column 2, lines 40-44, wherein the lid can be made to return automatically into a half open position "owing to the elastic restoring force of the hinge piece 6." That is completely contrary to the in-structure of the present invention as set forth in instant application independent claim 10 wherein the elastomeric element exerts a force to urge the two members from the closed position toward the open position.

Further, nowhere does Kleissendorf describe or suggest a hinge structure wherein the outer surface of the elastomeric element is in tension when the structure is closed, and wherein the inner surface of the elastomeric element is in compression when the structure

is closed.

Wright similarly fails as an effective reference. Wright discloses a hinge member14 which consists of a projection extending rearwardly from the body skirt 11 and a similar projection extending from the lid 12 wherein the body projection and lid projection are joined along a thin pivot line or hinge line. As set forth in the Wright patent, at column 5, lines 33-36, the lid may be of a type that holds the lid "in either of a closed or open position." Wright identifies a number of different types of hinges, such as a plastic strap, a live hinge, or a toggle type hinge. However, Wright does not teach a hinge wherein the structure includes "an elastomeric element" as set forth in the instant application independent claims 10, and wherein such an elastomeric element has an outer surface that is in tension when the structure is closed and that has an inner surface which is in compression when the structure is closed.

The Examiner has the initial burden of establishing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 U.S.P.Q. 2d 1461 (BPAI 1990). Here, the Examiner has not discharged that initial burden.

Further, it is improper for the Examiner to suggest that one of ordinary skill in the art might somehow modify the teachings of a prior art reference and look to a probability or possibility that a claimed structure is inherent in the prior art teachings. In In re Robertson, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999), the Court of Appeals for the Federal Circuit considered the Patent Office Board of Appeals holding that a prior art reference

disclosed a specific feature, and the court noted that "the Board's analysis rests upon the very kind of probability or possibility...that this court has pointed is insufficient to establish inherency."

Further, as noted in Motorola v. Interdigital Technology, 43 U.S.P.Q. 2d 1481 (Fed. Cir. 1997), "...[P]resumed knowledge does not grant a license to read into the prior art reference teachings that are not there."

The art cited by the Examiner has not been shown to leave a person of ordinary skill in the art with anything more than a choice of possibilities, and there is no showing that, or reason to believe that, the cited references disclose structures which have inherent features that would be recognized by a person of ordinary skill in the art as being anticipating with respect to the features set forth in the instant application independent claim 10 relating to the tension of the elastomeric element outer surface and the inner compression of the elastomeric element inner surface when the structure is closed.

In view of the above discussion, it is believed that independent claim 10, and its dependent claims are not anticipated by the cited prior art. Accordingly, withdrawal of the rejection of those claims is respectfully requested.

With respect to dependent claim 14 which was rejected under 35 U.S.C. §103(a) as being unpatentable over either Kleissendorf or Wright, dependent claim 14 includes all of the features of independent claim 10 discussed above. Those features, especially with respect the elastomeric element outer surface tension and inner surface compression, are not taught or even remotely suggested by the cited references. Accordingly, withdrawal of the rejection of dependent claim 14 under 34 U.S.C. §103(a) is respectfully requested.

Further, it is believed that this entire application is now in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on June 11, 2004.

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